

REMARKS

No claims have been amended or canceled. Independent claims 1, 8, and 18 remain in their previously presented form. Accordingly, claims 1-9, 12-13, and 17-28 remain pending in this application.

Claims 1-7

Independent claim 1 and particular dependent claims were rejected under 35 U.S.C. § 102(b) as being anticipated by Struhl (U.S. Patent No. 5,275,438). Applicants respectfully submit that Struhl fails to disclose each and every limitation described in claim 1. Also, Independent claim 1 and particular dependent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guderyon (U.S. Patent No. 5,288,144) in view of Struhl. Applicants respectfully submit that, even if there was a suggestion in the prior art to combine Guderyon and Struhl, the proposed combination fails to disclose all of the claim elements set forth in claim 1.

Regarding the §102(b) rejection based upon Struhl, the Struhl reference fails to disclose several elements described in claim 1. For example, Struhl fails to disclose “a greeting card” as described in claim 1.¹ Instead, Struhl discloses “a file folder with a transparent computer disc pocket.” (See col. 1, lines 7-8.) Struhl discloses that the file folder 2 and pocket 18 “provide a combined storage system for computer discs and corresponding paper copy” (e.g., 8.5x11” paper, A4 paper, legal-sized paper), but nothing in Struhl teaches “a greeting card” as described in claim 1. (See col. 1, lines 44-46; col. 2, lines 25-29.) In another example, Struhl fails to disclose a “collapsible bag structure” that is “adjustable to a collapsed condition” as described in claim 1. Rather, Struhl merely discloses that a flat pocket 18 has rear and front walls 20 and 30 directly connected along the bottom and side edges. (See col. 3, lines 48-51.) The flat pocket 18 is hingedly connected to a cover flap 42, which can pivot over the flat pocket 18, but in no way is the flat pocket 18 adjusted to collapsed condition. (See col. 3, lines 52-56; FIG. 3.) Accordingly, Struhl fails to disclose each and every element of claim 1, and thereby fails to anticipate claims 1-7 under 35 U.S.C. § 102(b).

¹ The claim preamble can distinguish the prior art when it “serve[s] to further define the structure of the article produced.” MPEP § 2111.02 (citing *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951)).

Regarding the §103 rejection based upon Guderyon in view of Struhl, the Guderyon reference fails for at least the same reasons as the Struhl reference. First, Guderyon fails to disclose or suggest “a greeting card” as described in claim 1. Instead, Guderyon discloses “a file folder for storing paper-based information and an associated holder for storing a computer disk.” (*See* col. 3, lines 26-28; FIG. 1.) Thus, even if the teachings of Guderyon and Struhl were combine as proposed by the Office Action, the proposed combination would yielded nothing more than a file folder—not a greeting card. Second, Guderyon fails to disclose or suggest a “collapsible bag structure” that is “adjustable to a collapsed condition” as described in claim 1. Rather, Guderyon discloses a flat pocket 8 “define[d]” by a front and back walls 22 and 24 so as to “snugly hold” a computer disk. (*See* col. 4, lines 8-16.) The flat pocket 8 is hingedly connected to a closure flap 42, which can pivot over the flat pocket 8, but in no way is the flat pocket 8 adjusted to collapsed condition. (*See* col. 3, lines 52-56; FIG. 3.) Accordingly, even if there was a suggestion in the prior art to combine Guderyon and Struhl as proposed by the Office Action, such a combination would fail to disclose all of the elements of independent claim 1 (as required by MPEP § 2143.03).

Applicants respectfully submit that independent claim 1 and dependent claims 2-7 are patentable over the cited references of record and are in condition for allowance.

Claims 8-9, 12-13, 17, and 28

Independent claim 8 and particular dependent claims were rejected under 35 U.S.C. § 102(b) as being anticipated by Struhl (U.S. Patent No. 5,275,438). Applicants respectfully submit that Struhl fails to disclose each and every limitation described in claim 8. Also, Independent claim 8 and particular dependent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guderyon (U.S. Patent No. 5,288,144) in view of Struhl. Applicants respectfully submit that, even if there was a suggestion in the prior art to combine Guderyon and Struhl, the proposed combination fails to disclose all of the claim elements set forth in claim 8.

Regarding the §102(b) rejection based upon Struhl, the Struhl reference fails to disclose several elements described in claim 8. For example, as previously described, Struhl discloses a

file folder 2 with a transparent computer disc pocket 18—not “a greeting card” as described in claim 8. (See col. 1, lines 7-8.) In further example, Struhl fails to disclose a “means for retaining and substantially enclosing a gift card” as set forth in claim 8. According to the MPEP, “the application of a prior art reference to a means or step plus function limitation requires that the prior art element perform *the identical function specified in the claim*. MPEP § 2182 (emphasis added). Struhl discloses that a pocket 18 stores a computer disc 40 (col. 3, lines 24-26), but Struhl fails to teach the identical function specified in the means-plus-function claim element (e.g., retaining and substantially enclosing a gift card), thereby failing to satisfy the requirement in MPEP § 2182. For at least these reasons, Struhl fails to anticipate claims 8-9, 12-13, 17, and 28 under 35 U.S.C. § 102(b).

Regarding the §103 rejection based upon Guderyon in view of Struhl, the Guderyon reference fails for at least the same reasons as the Struhl reference. First, as previously described, even if the teachings of Guderyon and Struhl were combine as proposed by the Office Action, the proposed combination would yielded nothing more than a file folder—not “a greeting card” as described in claim 8. Second, Guderyon fails to disclose or suggest a “means for retaining and substantially enclosing a gift card” as set forth in claim 8. Guderyon teaches that a pocket 8 stores a computer disk 12 (col. 4, lines 8-16), but Guderyon fails to teach the identical function specified in the means-plus-function claim element (e.g., retaining and substantially enclosing a gift card), thereby failing to satisfy the requirement in MPEP § 2182. Accordingly, even if there was a suggestion in the prior art to combine Guderyon and Struhl as proposed by the Office Action, such a combination would fail to disclose all of the elements of independent claim 8.

Applicants respectfully submit that independent claim 8 and dependent claims 9, 12-13, 17, and 28 are patentable over the cited references of record and are in condition for allowance.

Claims 18-27

Independent claim 18 and particular dependent claims were rejected under 35 U.S.C. § 102(b) as being anticipated by Struhl (U.S. Patent No. 5,275,438). Applicants respectfully

submit that Struhs fails to disclose each and every limitation described in claim 18. Also, Independent claim 18 and particular dependent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guderyon (U.S. Patent No. 5,288,144) in view of Struhs. Applicants respectfully submit that, even if there was a suggestion in the prior art to combine Guderyon and Struhs, the proposed combination fails to disclose all of the claim elements set forth in claim 18.

Regarding the §102(b) rejection based upon Struhs, the Struhs reference again fails to disclose several elements described in claim 18. For example, as previously described, Struhs discloses a file folder 2 with a transparent computer disc pocket 18—not “a greeting card” as described in claim 18. (*See* col. 1, lines 7-8.) In another example, Struhs fails to disclose a container “wherein when the prepaid gift card is releasably retained by the container, at least one dimension of the prepaid gift card is larger than the internal space such that the prepaid gift is partially exposed.”² Here, Struhs discloses that a pocket 18 stores a computer disc 40 (col. 3, lines 24-26), but Struhs fails to teach that the dimensions of the pocket 18 are such that a prepaid gift card is partially exposed when retained in the pocket 18. To the contrary, Struhs teaches that the pocket 18 is large enough to fully enclose and store the pocket contents (the computer disc 40). (*See* FIG. 2.) For at least these reasons, Struhs fails to anticipate claims 18-27 under 35 U.S.C. § 102(b).

Regarding the §103 rejection based upon Guderyon in view of Struhs, the Guderyon reference fails for at least the same reasons as the Struhs reference. First, as previously described, even if the teachings of Guderyon and Struhs were combine as proposed by the Office Action, the proposed combination would yield nothing more than a file folder—not “a greeting card” as described in claim 18. Second, Guderyon fails to disclose or suggest a container “wherein when the prepaid gift card is releasably retained by the container, at least one dimension of the prepaid gift card is larger than the internal space such that the prepaid gift is

² The Office Action improperly ignored some claim elements in claim 18 and contended that “[l]imitations drawn to the object to be placed in the container are merely statements of intended use.” (Office Action at pages 3 and 5.) Such an analysis is improper according to the MPEP. For example, MPEP § 2111.04 states that “wherein” clauses cannot be ignored when the element describes “a particular structure.” Here, claim 18 describes a relative size limitation for the internal space of the container, yet the Office Action provided no analysis of how the cited references allegedly disclose this claim element.

partially exposed.” Guderyon discloses that a pocket 8 stores a computer disk 12 (col. 3, lines 49-52), but Guderyon fails to teach that the dimensions of the pocket 8 are such that a prepaid gift card is partially exposed when retained in the pocket 8. Rather, Guderyon teaches that the pocket 8 is large enough to fully enclose the computer disk 12. (See col. 4, lines 8-16; FIG. 2.) Accordingly, even if there was a suggestion in the prior art to combine Guderyon and Struhl as proposed by the Office Action, such a combination would fail to disclose all of the elements of independent claim 18.

Applicants respectfully submit that independent claim 18 and dependent claims 19-27 are patentable over the cited references of record and are in condition for allowance.

Indication that references have been considered

Applicant notes that two entries on the PTO Form 1449 that accompanied the information disclosure statement filed April 12, 2005 were not initialed by the Examiner. The “Pocket Bag product” and “Card in a Bag product” references (designated IDs AFFFF and AGGGG) were submitted as color photocopies of actual samples of a bag product. A set of courtesy copies (in color) were provided to the Examiner in the previous Reply. Applicant respectfully repeats the previous request that the two entries be initialed on the Form 1449, indicating that the references have been considered. Applicant respectfully notes that, according to MPEP § 609.05(b), “[e]xaminers **must** consider all citations submitted in conformance with the rules.” If further information is needed concerning these two references, the Examiner is invited to contact the undersigned attorney.

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No fee is believed to be due at this time. If necessary, please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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